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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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EXAMINER			

33N1/1202

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REICHLER, K	PAPER NUMBER
ART UNIT	4

3308

DATE MAILED: 12/02/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on

3-27-97 & 6-2-97

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.
☐ Claim(s) _____ is/are allowed.
☒ Claim(s) 1-27 is/are rejected.
☐ Claim(s) _____ is/are objected to.
☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-848.
☒ The drawing(s) filed on 3-27-97 is/are objected to by the Examiner.
☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
☒ The specification is objected to by the Examiner.
☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
☐ All ☐ Some ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.
☐ received in Application No. (Series Code/Serial Number) _____
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☒ Notice of Reference Cited, PTO-892
☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3
☐ Interview Summary, PTO-413
☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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The abstract of the disclosure is objected to because the legal phraseology "the present invention comprises" should be avoided. Also, on line 4, "the" (first occurrence) should be --a--. Correction is required. See MPEP § 608.01(b).

mm 12-1-92 The drawings are objected to because in Figures 3-8, Applicant uses the same numerals in these Figures as in Figures 1-2 although the structures are not the same, e.g. sheet 62 in Figure 1 has a slit 41 whereas in Figure 3 it has a window 44. Compare also elements 42, 43, etc. In Figures 7, 8 and 10, the numeral 55 is used to denote 3 different structures. Correction is required.

mm 12-1-92 The disclosure is objected to because of the following informalities: Page 2, lines 18-24 and page 6, lines 15-22 are incomplete. On, e.g., page 3, line 30, and in the abstract the terminology "discontinuous" and "substantially fluid impervious" appears to be inconsistent. On page 9, line 33, and page 10, line 2, "7A" should be --8--. On page 15, line 31, "14" should be --10--. *mm 12-1-92* The description on page 25, lines 12-14 is inaccurate, i.e. there is one layer 52 or two layers 51 in Figures 9 and 10. In Figures 14 and 15 what is the roller vertically between 93 and 95? Also, the descriptions of Figures 3-8 and 10 are considered to be improper for the same reason as discussed supra in the drawing objections, i.e. same numerals for different structures.

Appropriate correction is required.

The prior art cited by Applicant throughout the specification has been noted but unless cited on a PTO-1449 or 892, if any, has not been considered, i.e. will not appear on the front of a patent, if any, since such citations are not in compliance with 37 CAR 1.56, 1.97 and/or 1.98.

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Applicant is reminded that incorporation of essential subject matter, i.e. claimed subject matter, by reference to foreign patents or foreign patent applications or U.S. patents or patent applications which themselves incorporate essential subject matter by reference is improper. Applicant should carefully review the incorporations in the instant application to ensure that they are proper.

The use of the trademark (page 7, line 19) Velcro has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Trademarks should be in all capital letters, between quotation marks, and accompanied by generic terminology.

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In regard to claim 1, a positive structural connection between the sheet and core component should be defined, i.e. the claim lists a catalog of unconnected elements. In regard to claim 10, a positive structural antecedent basis for "each ... layers" should be defined. In regard to claim 11, line 5, Applicant inferentially includes the wearer as part of the claimed combination which is contrary to the preamble of the claim.

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Claims 6, 21 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the claims Applicant defines his/her invention in terms of a result of a particular test(s), in this case absorption pressures. It is a basic premise in order to pass muster under 35 U.S.C. § 112 second paragraph, that one of ordinary skill in the art must be able to determine with absolute certainty whether every particular article necessarily falls within the scope of that claim or outside the scope of that claim. Since a myriad of testing rooms conditions, material(s) age, testing location, and the like cause changes in the results of the various tests claimed, it is an absolute certainty that at least one article will fall within the scope of the claims given a first set of conditions and outside the scope of the claims given a second set of conditions. This being so, the

12-187 Claims are indefinite. See, for example, Ex parte Kristensen, 10 USPQ2d 1701 (Bd. Pat. App. & Inter. 1989).

Courts have held that with respect to the second paragraph of section 112, the inquiry is "to determine whether the claims do, in fact, set out and circumscribe a particular area with a reasonable degree of precision and particularity".

All provisions of the statute must be complied with in order to obtain a patent. The requirement stated in the second paragraph of section 112 existed long before the present statute came into force. Its purpose is to provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

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12-1-21 Compare United Carbon Co. v. Binney Co., 317 U.S. 228, 55 USPQ 381 (1942), Kaiser Industries Corp., 400 F.2d 36, 158 USPQ 565 (6th Cir. 1968), quoted in Ex parte Kristensen, 10 USPQ2d 17-01, 1703 (BPAI 1989).

As set forth above, the purpose of 35 U.S.C. section 112, second paragraph, is to ensure that one skilled in the art after reading the specification and the claims would necessarily be able to readily determine whether a potentially infringing device necessarily lies within or without the scope of the claim. In the instant case, a party desiring to enter the market would first have to construct a model of their device. Then they would have to read the patent, specifically the claims and determine whether further inquiry is required, as to whether their device might fall within the scope of the patented claims. Next, the party would have to buy or construct the testing equipment and finally test their device at numerous conditions to determine whether their device infringes upon the patented claims. Such claim language, if patented, raises a substantial barrier and burden upon any party desiring to enter the market, as it does not allow a party to readily and accurately determine the boundaries of the patented claims. As the claims do not provide adequate notice demanded by due process of law, so that one may readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance, the Examiner considers the claims to be indefinite. In other words, since one skilled in the art would not necessarily be able to determine from a reading of the specification and the claims whether a potentially infringing article necessarily would be within or outside the scope of the claims 6, 21 and 27, these claims are considered indefinite.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Roessler et al

12-7-12 342. See Figure 11. Also, note the claim does not require the periphery to be that of the backsheet nor direct affixation.

Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Buchler or Schiff.

The opening is define by flaps 20 of Buchler or see Figures of Schiff.

Claims 1, 7, 8, 11, 16, and 23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lewis. See Figures 1 and page 2, lines 26-91.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis in view of Murphy. Applicant claims an impervious blocking layer disposed between removable absorbent core layers or more specifically a blocking layer attached to one core member at at least two second absorbent core members which are independently removable which Lewis does not

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12-19 teach. Lewis teaches a pad of multiple core layers which is insertable and removable from a pocket through an opening in an outer sheet or between outer sheets. However, Murphy teaches one or more pads with or without a layer, an exterior pad layer of waterproof material which is insertable and removable from a pocket through an opening in an outer sheet which are separately aired and dried, i.e. independently removable. To make the pad without a blocking layer of Lewis multiple independently aired and dried pads including blocking sheets would be obvious in view of the interchangeability as taught by Murphy.

Claims 1 and 7-11, 16 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Lewis. The Murphy device includes all the claimed structure except for providing access through the backsheet or between the front and back sheets, i.e. access in Murphy is through the front sheet. See page 2, line 62-91 of Lewis. To make the front sheet access of Murphy backsheet or between front and back sheets access would be obvious in view of the interchangeability as taught by Lewis.

12-19 Claims 3-6, 12-15, 17-21 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy or Lewis. Applicant claims core component composition or absorption pressures which Murphy and Lewis do not teach. However no portion of the file sets forth any of the specific structural features claimed provide any new result or solve any recognized problem in the art over the prior art device of Murphy or Lewis. As such, the Examiner is required by the holding of numerous prior decisions by The Board of Patent Appeals & Interferences relying on In re Kuhle, 188 USPQ 7, to conclude that the specifics claimed are merely a matter of

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engineering design choice, and thus do not serve to patentably distinguish the claimed invention over the prior art.

*may
12-1-97*
Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roessler et al **342**. Applicant claims certain compositions and pressures. The rejection in the immediately preceding paragraph also applies here to Roessler et al with respect to claims 26-27.

Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buchler or Schiff. Applicant claims certain compositions and pressures. The rejection in the immediately preceding two paragraphs also applies here to Buchler or Schiff.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other prior art shows various access openings and core configurations.

Any inquiry concerning this communication should be directed to K. Reichle at telephone number (703) 308-2617.

K. Reichle:lf
November 25, 1997

K. Reichle
KARIN REICHLE
PATENT EXAMINER
ART UNIT 3308